

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSHUA J. MALONE
and JEFFREY E. FARIS

Appeal No. 2005-2711
Application No. 10/028,015¹

MAILED

JAN 12 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before JERRY SMITH, BARRETT and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-9. Claims 10-19 have been withdrawn from consideration as drawn to a non-elected invention.

We affirm.

BACKGROUND

Appellants' invention is directed generally to the placement of an indicia on an integrated circuit package to indicate the orientation of the package. Specifically, Appellants provide for

¹ Application for patent filed December 21, 2001 which claims the filing priority benefit under 35 U.S.C. § 119 of the provisional Application No. 60/258,993, filed December 29, 2000.

an intermediate metallization layer on a lower portion of a package to remain visible beyond the extent of an upper portion of the package for indicating an orientation of the package. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A substrate for a device package comprising:
 - a lower portion of a package;
 - an intermediate metallization layer on a top surface of said lower portion;
 - an upper portion of said package on said top surface of said lower portion, a corner portion of said intermediate metallization layer remaining visible beyond the extent of said upper portion for indicating an orientation of said substrate.

The Examiner relies on the following references:

Guzuk et al. (Guzuk)	5,153,379	Oct. 6, 1992
Ueda et al. (Ueda)	6,037,698	Mar. 14, 2000

Claims 1 and 3-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Guzik.

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ueda.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik.

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Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellants and the Examiner. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

With respect to the 35 U.S.C. § 102 rejection of the claims over Guzuk, we initially note that a rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to

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"'read on' something disclosed in the prior art reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." See also Atlas Powder Co. v. IRECO Inc., 190 F.3d at 1346, 51 USPQ2d at 1945 (Fed. Cir. 1999) (quoting Titanium Metals Corp. v. Banner, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985)).

Appellants argue that the intermediate metallization layer 114 of Guzuk (shown in Figure 4a) does not indicate "an orientation of said substrate," as recited in claim 1, because each corner of Guzuk's package looks identical (brief, page 5). The Examiner responds by stating that the visible portion of metallization layer 114 "can show whether the lower package portion is showing the wrong side up or not" (answer, page 5). The Examiner additionally asserts that providing a visible portion of the metallization for indicating an orientation of the substrate is a recitation of the intended use and is met by the prior art if the reference shows a structure that is capable of performing that function (answer, page 6). However, in response, Appellants contend that determining the orientation of a package is well known in the art to be related to the orientation of the electrical connection (reply brief, page 3).

We agree with the Examiner's position that Guzuk provides for a portion of the metallization layer 114 to be left uncovered by upper portion 104/102 of the package and remains visible from the corners of the upper portion. See Figures 1 and 4a of Guzuk. In particular, we find appellants' argument (reply brief, page 3) that the claimed orientation relates only to the orientation of the package with respect to the electrical connections to be overreaching. The visible metallization in claim 1 is recited to be for "indicating an orientation of said substrate" which relates, not only to the electrical connection, but the general orientation of the package substrate. Therefore, as stated by the Examiner (answer, page 6), to the extent that the visible portion of metallization layer in the prior art performs the recited intended use, the claimed function of "indicating an orientation of said substrate" reads on the structure disclosed by Guzuk.

Although the Examiner's characterization of the orientation of the substrate appears to be different from the orientation argued by Appellants, the claims do not require the orientation of the package be related to only electrical connections. The specification also refers to "orientation of the package" without

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limiting it to the orientation of the package with respect to the electrical connections, as Appellants would have wanted us to believe.

Based on our findings above, we agree with the Examiner that Guzuk prima facie anticipates the claimed subject matter in the representative independent claim 1. Accordingly, we sustain the 35 U.S.C. § 102(b) rejection of claim 1 as well as claims 3-8, which fall with their base claim as they have not been separately argued.

We now consider the rejection of claims 1 and 2 as anticipated by Ueda. Upon our review of the reference, we remain unconvinced by Appellants that the relied on portion of Ueda does not teach the claimed metallization layer (brief, page 5). In particular, we find the Examiner's characterization of layer 53 which extends beyond a corner of the upper portion 6 for indicating an orientation of the package to be reasonable. Although portion 53 is referred to as the cap connecting pattern (col. 10, line 54), it is an extension of die-attach portion 16, which is conducting metallization layer on the lower portion of the package and is ultimately connected to ground terminal 14 (col. 10, lines 48-53). Therefore, in view of the Examiner's

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explanation of the prior art teachings and the claimed elements, we agree with the Examiner that Ueda prima facie anticipates the claimed subject matter of independent claim 1 and dependent claim 2. Accordingly, the 35 U.S.C. § 102(e) rejection of claims 1 and 2 is sustained.

Turning now to the 35 U.S.C. § 103 rejection of claim 9, we note that Appellants merely rely on the arguments made with respect to base claim 1. Therefore, we find the subject matter of claim 9 to be obvious over the teachings of Guzik for the same reasons discussed above with respect to independent claim 1. Thus, we find that the examiner has established a reasonable case of prima facie obviousness and sustain the 35 U.S.C. § 103 rejection of the claim 9 over Guzik.

CONCLUSION

In view of the foregoing, the decision of the Examiner to reject claims 1-8 under 35 U.S.C. § 102 and rejecting claim 9 under 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

Jerry Smith

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Administrative Patent Judge)
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